

**REMARKS/ARGUMENTS****I. General Remarks**

Applicants respectfully request that the above amendments be entered, and further request reconsideration in light of the amendments and remarks contained herein.

At the time of the Office Action, claims 21, 29, 31, 37, and 44-48 were pending. In this response, Applicants have amended claims 21 and 44. Applicants respectfully submit that these amendments add no new matter to the application and are supported by the specification as originally-filed. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants thank the Examiner for his careful consideration of this application.

**II. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 102(b)**

Claims 21, 29, 44, 45, and 47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,420,174 issued to Dewprashad (hereinafter "*Dewprashad*"). With respect to this rejection, the Office Action states:

Dewprashad (column 1, lines 26 et seq; and claims) discloses it is common in the treatment of formations to coat or encapsulate proppants with natural or synthetic film-forming materials. Dewprashad further discloses the resin coated proppant in aqueous gelled fluids formed by cross-linking rheological agents with conventional [crosslinkers] comprising aluminum and titanium cross-linking agents. These are conventionally in the form of soluble salts. Dewprashad (column 2, lines 16 et seq) further teaches metal salts may be incorporated as gel breakers in the form of lithium hypochlorite.

The resin coated proppant would be further gel coated with a metal salt crosslinked gel and/or include a further gel breaker. Applicants do not distinguish the Applicant's intended use as a proppant with tracking material does not distinguish (In re Pearson 181 USPQ 641).

(Final Office Action at 3.) Applicants respectfully disagree and submit that *Dewprashad* does not disclose each and every element of independent claims 21 and 44, as required to anticipate the claims under § 102(b). *Manual of Patent Examining Procedure* (2007) (hereinafter "MPEP") § 2131.

In particular, *Dewprashad* does not disclose a particulate material wherein the particulate material has been coated with a coating composition comprising a tracking

composition “selected from the group consisting of: a metal salt wherein the metal portion is selected from the group consisting of gold, silver, lithium, molybdenum, nickel, phosphorus, and vanadium; and a metal salt selected from the group consisting of barium bromide, barium iodide, beryllium fluoride, beryllium bromide, beryllium chloride, cadmium bromide, cadmium iodide, chromium bromide, chromium chloride, chromium iodide, cesium bromide, cesium chloride, sodium bromide, sodium iodide, sodium nitrate, sodium nitrite, potassium iodide, potassium nitrate, manganese bromide, zinc bromide, zinc iodide, sodium monofluoroacetate, sodium trifluoroacetate, sodium 3-fluoropropionate, potassium monofluoroacetate, potassium trifluoroacetate, and potassium 3-fluoropropionate.” Rather than disclosing such a proppant composition, *Dewprashad* discloses that proppant may be coated with a resole-type phenolic resin, placed in a gelled fluid, and then once placed in the formation, the gelled fluid may be broken with aqueous gelling agent breakers, none of which are the tracking compositions claimed by Applicants. *See* col. 2, lines 8-25.

Therefore, Applicants respectfully submit that independent claims 21 and 44 are not anticipated by *Dewprashad*. Claims 29, 45, and 47 depend, either directly or indirectly, from independent claim 21 or 44 and therefore include all the elements of the independent claim from which they each depend. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of this rejection.

### **III. Remarks Regarding Rejection of Claims Under 35 U.S.C. §§ 102(b) and 103(a)**

Claims 21, 29, 31, 37, and 44-48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,785,884 issued to Armbruster (hereinafter “*Armbruster*”). With respect to this rejection, the Office Action states:

Armbruster (abstract; column 1, lines 9 et seq; column 3, lines 35 et seq; particularly lines 58-60; column 5, lines 8-24; examples and claims) disclose the coating of proppants with resin employing catalyst salts at up to 10 % by weight including at least Cu, Al, Fe, Mg, and Co salts of nitrates and chlorides among others.

To the extent the *Armbruster* reference differs in the disclosure of the catalyst with sufficient specificity, It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ known acid at least Cu, Al, Fe, Mg, and Co salts of nitrates and chlorides among other salts as

catalyst taught in the *Armbruster* reference for the advantageous *Armbruster* taught catalytic function as clearly contemplated therein.

(Final Office Action at 4.) Applicants respectfully disagree and submit that *Armbruster* does not disclose, teach or suggest each and every element of independent claims 21 and 44, and those elements not taught or suggested by *Armbruster* are not rendered obvious in any manner, as required to obviate the claims under §103(a). MPEP §§ 2131, 2143.

In particular, *Armbruster* does not disclose “a substantially non-radioactive tracking material selected from the group consisting of: a metal salt wherein the metal portion is selected from the group consisting of gold, silver, lithium, molybdenum, nickel, phosphorus, and vanadium; and a metal salt selected from the group consisting of barium bromide, barium iodide, beryllium fluoride, beryllium bromide, beryllium chloride, cadmium bromide, cadmium iodide, chromium bromide, chromium chloride, chromium iodide, cesium bromide, cesium chloride, sodium bromide, sodium iodide, sodium nitrate, sodium nitrite, potassium iodide, potassium nitrate, manganese bromide, zinc bromide, zinc iodide, sodium monofluoroacetate, sodium trifluoroacetate, sodium 3-fluoropropionate, potassium monofluoroacetate, potassium trifluoroacetate, and potassium 3-fluoropropionate,” as recited in independent claims 21 and 44, as amended herein.

Rather, *Armbruster* discloses curing catalysts such as “acids with a pKa of about 4.0 or lower, such as phosphoric, sulfuric, nitric, benzenesulfonic, toluenesulfonic, xylenesulfonic, sulfamic, oxalic, salicylic acid, and the like; water soluble multi-valent metal ion salts such as the nitrates or chlorides of metals including Zn, Pb, Ca, Cu, Sn, Fe, Mn, Mg, Cd and Co.” *Armbruster*, col. 5, lines 8-16. Such curing catalyst compositions do not teach, suggest, or otherwise render obvious the tracking materials recited in independent claims 21 and 44. Furthermore, the Final Office Action states that “the *Armbruster* reference discloses phosphorous salts, which the claims read.” (Final Office Action at 5.) Applicants respectfully disagree and submit that *Armbruster* discloses catalysts such as phosphoric acid, rather than a metal salt wherein the metal portion is selected from the group consisting of phosphorus, as claimed by Applicants. *Armbruster*, col. 5, line 9.

Therefore, Applicants respectfully submit that independent claims 21 and 44 are not anticipated or obviated by *Armbruster*. Claims 29, 31, 37, and 45-48 depend, either directly

or indirectly, from independent claim 21 or 44 and therefore include all the elements of the independent claim from which they each depend. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of this rejection.

#### **IV. No Waiver**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

#### **SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe there are no fees due in association with the filing of this response. Should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a petition therefor, and direct that any additional fees be charged to Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.1133.

Respectfully submitted,

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